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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Terumasa MIYAHARA et al. Group Art Unit: 3723

Application No.: 10/576,368 Examiner: M. RACHUBA

Filed: April 19, 2006 Docket No.: 126784

For: OPTICAL DISK-RESTORING APPARATUS

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the July 12 Restriction Requirement, Applicants provisionally elect Group II, species 2b, with traverse. At least claims 7 and 17 read on the elected species, with claim 7 being generic.

The Election of Species Requirement is strongly traversed as being contrary to PCT rules. Specifically, Article 27 of the Patent Cooperation Treaty requires that "no national law shall require compliance with requirements relating to the form or contents of the international application different from or in addition to those which are provided for in this Treaty and the regulations."

Applicants respectfully submit that there exists *a priori* unity of invention at least with respect to claims 7-19, by virtue of the fact that claims 8-19 variously depend from claim 7. As stated in Chapter 10.06 of the ISPE (*International Search and Preliminary Examination Guidelines*):

> Unity of invention has to be considered in the first place only in relation to the independent claims in an internation application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed.

Therefore, each dependent claim shares at least each element or technical feature with independent claim 7.

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unit arises in respect to any claims that depend on the independent claims. In particular, without conceding the propriety of the Office Action's characterization of Applicants application, it does not matter if a dependent claim contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of independent claim 7 is known in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus an election of species requirement at this time is improper.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,

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